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10/823,439	04/13/2004	Volkmar Teichgraber	30691/DP016	4835
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MARSHALL, GERSTEIN & BORUN LLP			LIOU, ERIC	
233 S. WACKER DRIVE, SUITE 6300				
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CHICAGO, IL 60606			3628	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/823,439

Applicant(s)

TEICHGRABER ET AL.

Examiner

Eric Liou

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Status of Claims*

Applicant has amended claims 1-3, 7, and 9. Claims 1-9 remain pending and are presented for examination.

### *Response to Arguments*

1. Applicant's arguments filed 10/24/07 have been fully considered but they are not persuasive.
2. Applicant argues, "Didriksen fails to disclose or suggest first detecting information on a mail piece and then applying an identification code to the mail piece." However, independent claim 1 recites, "detecting information present on at least one surface of a mailpiece and applying a machine-readable identification code onto the mailpieces." In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., first detecting information on a mail piece and then applying an identification code to the mail piece) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, claims must be interpreted as broadly as their terms reasonably allow. See *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989) and *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Didriksen teaches detecting information present on at least one surface of a mailpiece and applying a machine-readable identification code onto the mailpieces (Didriksen: pg. 3, lines 20-24; pg. 7, lines 15-20; pg.8, lines 1-3; pg. 25, lines 17-19; pg.26, lines 9-13; pg. 27, lines 20-22). Thus, the Examiner maintains that Didriksen discloses all of the limitations of claim 1 as written.

Claim 9 recites limitations substantially similar to claim 1 and is rejected under the same rationale as described above.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Didriksen, PCT International Application WO 00/00300.

5. **As per claim 1**, Didriksen discloses a method for processing mailpieces comprising:

(a) detecting information present on at least one surface of a mailpiece and applying a machine-readable identification code onto the mailpieces (Didriksen: pg. 3, lines 20-24; pg. 7, lines 15-20; pg.8, lines 1-3; pg. 25, lines 17-19; pg.26, lines 9-13; pg. 27, lines 20-22);

(b) transmitting the detected information and an appertaining identification code to an interface computer (Didriksen: pg. 3, lines 25-26; pg. 7, lines 26-30; pg. 25, lines 19-22) and storing the detected information and the appertaining identification code (Didriksen: pg. 7, lines 15-20 and 30-33; pg. 25, lines 21-22);

(c) accessing the stored information and the stored identification code (Didriksen: pg. 7, lines 15-20 and 30-33; pg. 26, lines 3-5) and determining address information on the basis of the detected and stored information (Didriksen: pg. 7, lines 15-20 and 26-30; pg. 8, lines 5-6);

(d) comparing the detected address information with address information present in a database

(Didriksen: pg. 11, lines 16-27; pg. 25, lines 31-34 – pg. 26, lines 1-5);

(e) associating the detected address information with new address information on the basis of the comparison that has been carried out (Didriksen: pg. 11, lines 16-27);

(f) transmitting the associated new address information and the appertaining identification code to the interface computer (Didriksen: pg. 7, lines 26-30; pg. 11, lines 16-27);

(g) detecting the identification code applied onto the mailpieces (Didriksen: pg. 8, lines 1-3) and applying the new address information onto the mailpiece, whereby the new address information is applied as a function of the identification code (Didriksen: pg. 11, lines 16-27).

6. **As per claim 2**, Didriksen discloses the method of claim 1 as described above. Didriksen further discloses processing the mailpieces according to a two-stage process, comprising preliminarily sorting the mailpieces and (Didriksen: pg. 10, lines 15-20; pg. 27, lines 29-32) separately, sorting the mailpieces into smaller units (Didriksen: pg. 10, lines 20-26; pg. 15, lines 16-25; pg. 28, lines 4-17), and detecting the information present on the surface of the mailpiece and converting the address information present on the mailpiece into the new address information during the preliminary sorting (Didriksen: pg. 11, lines 16-27; pg. 25, lines 31-34 – pg. 26, lines 1-13; pg. 27, lines 15-22).

7. **As per claim 3**, Didriksen discloses the method of claim 1 as described above. Didriksen further discloses ascertaining whether the detected address information contains a first postal code (Didriksen: pg. 3, lines 20-21; pg. 8, lines 1-3; pg. 25, lines 17-23), and converting the first postal code into a postal code that matches the new address information (Didriksen: pg. 11, lines 16-27).

8. **As per claim 4**, Didriksen discloses the method of claim 1 as described above. Didriksen further discloses applying the new address information onto the mailpiece in coded form (Didriksen: pg. 11, lines 16-27).

9. **As per claim 5**, Didriksen discloses the method of claim 4 as described above. Didriksen further discloses the address information comprises a barcode (Didriksen: pg. 26, lines 12-13).

10. **As per claim 6**, Didriksen discloses the method of claim 4 as described above. Didriksen further discloses the address information is at least partially in plain text (Didriksen: pg. 25, lines 17-19).

11. **As per claim 7**, Didriksen discloses the method of claim 2 as described above. Didriksen further discloses carrying out one of the preliminary sorting and the sorting the mailpieces into smaller units as a function of the new address information (Didriksen: pg. 27 lines 24-33 – pg. 28, lines 1-17).

12. **As per claim 8**, Didriksen discloses the method of claim 1 as described above. Didriksen further discloses transporting the mailpieces at least over a segment as a function of the new address information (Didriksen: pg. 10, lines 15-26; pg. 27, lines 24-33 – pg. 28, lines 1-17).

13. **As per claim 9**, Didriksen discloses a device for processing mailpieces comprising:  
a) a device that detects information present on at least one surface of the mailpieces (Didriksen: pg.19, lines 13-15; pg. 25, lines 17-19) and a printer to apply a machine-readable identification code onto the mailpieces (Didriksen: pg. 26, lines 9-13 – The Examiner notes, printing a code implies a printer.);

b) an interface computer comprising memory for storing the detected information (Didriksen: Figure 14, “207”; pg. 19, lines 9-11; pg. 25, lines 21-22; pg. 26, lines 5-9);

- c) processing stations comprising a processor that accesses the stored detected information and the appertaining stored identification codes, and the processor determines address information on the basis of the stored detected information (Didriksen: Figure 14, “207” and “208”; pg. 19, lines 16-19; pg. 25, lines 17-22; pg. 26, lines 3-5);
- d) a database comprising address information and a comparison unit that compares the detected address information with address information present in the database (Didriksen: pg. 25, lines 31-34 – pg. 26, lines 1-5),
- e) a processor that associates the detected address information with new address information on the basis of a comparison of the detected address information with the address information that is present in the database (Didriksen: Figure 14, “207” and “208”; pg. 11, lines 16-27);
- f) a transmitter that transmits the new address information and the identification code from the processing stations to the interface computer (Didriksen: Figure 2, “207”; pg. 30, lines 24-31; pg. 35, lines 5-6) and,
- g) a device that detects the identification code applied onto the mailpieces and a device that applies the new address information onto the mailpiece as a function of the identification code (Didriksen: pg. 11, lines 16-27; pg. 26, lines 9-13).

### *Conclusion*

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The Examiner has cited particular portions of the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the Applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Liou whose telephone number is 571-270-1359. The examiner can normally be reached on Monday - Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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PRIMARY EXAMINER